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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,249	06/20/2003	Bronwyn Syiek	3558100003	5556
23418	7590	06/26/2008		
VEDDER PRICE P.C. 222 N. LASALLE STREET CHICAGO, IL 60601			EXAMINER	
			ISMAIL, SHAWKI SAIF	
			ART UNIT	PAPER NUMBER
			2155	
			MAIL DATE	DELIVERY MODE
			06/26/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/600,249

**Applicant(s)**

SYIEK ET AL.

**Examiner**

SHAWKI S. ISMAIL

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 64-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **RESPONSE TO AMENDMENT**

1. This communication is responsive to the amendment received on April 29, 2008.

Claims 64-105 are pending further examination

### **The Previous Rejection Maintained**

2. The rejection is respectfully maintained as set forth in the last Office Action mailed on December 31, 2007. Applicants' arguments with respect to claims 64-105 received on April 29, 2008 have been fully considered but they are not persuasive and the previous rejection is maintained.

### **Claim Rejections - 35 USC §102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 64-105, are rejected under 35 U.S.C. 102(e) as being anticipated by **Prince** U.S. Patent application No. **20040148506A1**.
5. As to claim 64, Prince teaches a method of controlling electronic mail (e-mail) message transmission over a network comprised of:

receiving, by a third entity, a first set of encoded e-mail addresses from a first entity, wherein said first set of encoded e-mail addresses represents e-mail addresses to which an e-mail message could be sent (refer to paragraph 0059);

compiling, by said third entity, a second set of encoded e-mail addresses, wherein said second set of encoded e-mail addresses represents e-mail addresses to which said e-mail message should not be sent (refer to paragraph 0030); and

removing, by said third entity, from said first set of encoded e-mail addresses, each encoded e-mail address that is in said second set of encoded e-mail addresses thereby yielding a third set of encoded e-mail addresses, wherein said third set of encoded e-mail addresses represents e-mail addresses to which said e-mail message may be sent, wherein a second entity is a source of said e-mail message (refer to paragraph 0048).

6. As to claim 65 Prince teaches the method of claim 64 wherein receiving said first set of encoded e-mail addresses includes receiving a first set of hash coded e-mail addresses (refer to paragraph 0031).

7. As to claim 66 Prince teaches the method of claim 64 wherein said first entity is an e-mail mass mailer (refer to paragraph 0059).

8. As to claim 67 Prince teaches the method of claim 64 wherein removing, by said third entity, from said first set of encoded e-mail addresses, each encoded e-mail address that is in said second set of encoded e-mail addresses thereby yielding said third set of encoded e-mail addresses comprises:

sorting said first set of encoded e-mail addresses into a first ordered list of encoded e-mail addresses wherein said encoded e-mail addresses are in ascending order (refer to paragraph 0032);

sorting said second set of encoded e-mail addresses into a second ordered list of encoded e-mail addresses wherein encoded e-mail addresses are in ascending order; beginning with a first entry in said first ordered list of encoded e-mail addresses, and

beginning with a first entry in said second ordered list, comparing the first entry in said first ordered list to the first entry in said second ordered list then successive entries in said second ordered list, until the value of an entry in said second ordered list equals or exceeds the value of the first entry in said first list (refer to paragraph 0032); and

removing the first entry from said first list upon the detection in said second ordered list of the first entry in said first ordered list, thereby yielding said third set of encoded e-mail addresses (refer to paragraph 0032).

9. As to claim 68 Prince teaches the method of claim 64 further including sending said third set of encoded e-mail addresses to an e-mail mass mailer via a data network (refer to paragraph 0059).

a. As to claim 69 Prince teaches the method of claim 64 further including:  
identifying e-mail addresses that are encoded in said third set of encoded e-mail addresses (refer to paragraph 0059); and

e-mailing said e-mail message to said identified e-mail addresses (refer to paragraph 0059).

10. Claims 70-105 do not teach or define any new limitation above claims 64-69 therefore, they are rejected for similar reasons

11. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are

representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### Response to Arguments

12. Applicants' arguments have been fully considered however they are not deemed to be persuasive. The applicant argues in substance that Prince fails to teach applicant's claimed invention.

The examiner respectfully disagrees. Prince teaches a non-revealing do-not-contact list system in which a do-not-contact list of one-way hashed consumer contact information is provided to a set of one or more entities. Furthermore, Prince discloses several embodiments for restricting telemarketers or other entities from sending unsolicited e-mails to consumers that have requested not be contacted.

"FIG. 4 is an exemplary block diagram of an alternative embodiment of the Client Do-Not-Contact Application according to one embodiment of the invention. In FIG. 4, the Client Do-Not-Contact Application is hosted remotely and accessed by the client over a network. The client's list of entries to be checked against the do-not-contact list are transferred to the remote Client Do-Not-Contact Application (601a). The transfer of client entries may be accomplished via a network connection, e-mail, disk, scanned forms, etc. Once entries to be checked are transferred and, one-by-one, hashed (602), the Client Do-Not-Contact Application checks each hashed entry against the Client Do-Not-Contact List (603). Once all the client entries are checked, the remote Client Do-Not-Contact Application generates a report (604) and returns its information indicating which client entries appear on the Client Do-Not-Contact Application (604a). In one embodiment, the remote Client Do-Not-Contact Application returns all the client entries which do not appear on the Client Do-Not-Contact List in the form of a file. In an alternative embodiment, the remote Client Do-Not-Contact Application returns the client entries that appear on the Client Do-Not-Contact List. It should be understood that several alternative embodiments of the remote Client Do-Not-Contact Application are

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possible. These embodiments could receive or process client entries in different ways (e.g., receiving client entries in an encrypted form, returning specific subsets of the resulting data, returning the data in different form of files or streams of output, etc.).” (refer to paragraph 0039, emphasis added).

Prince teaches receiving by Client Do-Not-Contact Application a list of hashed e-mail address that may be contacted. The Client Do-Not-Contact Application compares the received list with the Client Do-Not-Contact List and returns the a modified list that contain hashed e-mail addresses not present in the Client Do-Not-Contact List and are permitted for communication. Therefore, Prince meets the scope of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shawki Ismail  
Patent Examiner  
June 21, 2008

/saleh najjar/

Supervisory Patent Examiner, Art Unit 2155